

REMARKS

Claim 2 is pending in the present application. Claim 2 has been amended by incorporating the subject matter of canceled claim 3. This is a clarifying and not a narrowing amendment. Thus, no new matter has been added. Further, the cancellation of claim 3 reduces the number of outstanding issues.

The amended claim also presents no new issues requiring further search or consideration, because pending claim 2 is of the same scope has previously been presented and subsequently examined.

In the alternative, if the Examiner continues with the rejection of the present application, it is respectfully requested that the present Reply be entered for purposes of an Appeal. The Reply reduces the issues on appeal by reducing the number of claims and/or overcoming the rejections under 35 U.S.C. § 103(a). Thus, the issues on appeal would be reduced.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicant respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 103(a)

Claims 2-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muraoka et al. (U.S. Patent No. 5,859,142, newly cited; hereinafter "Muraoka '142") in view of Majumdar et al. (U.S. Patent No. 5,503,940; hereinafter "Majumdar '940"), Matsue et al. (U.S. Patent No. 5,420,193, newly cited; hereinafter "Matsue '193") and Carter (U.S. Patent No. 5,807,918; hereinafter "Carter '918"). The rejection of claims 2-3 with regard to Takada as stated in the previous Office Action has been withdrawn (see paragraph 3 of the present Office Action). Applicant respectfully traverses the present rejection.

The features and advantages have been discussed in Applicant's previous reply (filed January 31, 2003), and herein incorporate those remarks. Applicant respectfully submits that a *prima facie* case of obviousness has not been formed with respect to the asserted combination of references for the following reasons.

The cited primary reference of Muraoka '142 is used to disclose certain features of the present invention, but is deficient in several respects. For example, this reference fails to disclose a nitrogen adsorption specific surface area of 70-120 m²/g for carbon black. Muraoka '142 also fails to disclose blending with 1,3-bis (citraconimidomethyl) benzene, or even using 0.2-0.5 parts by weight thereof. The other cited references of Majumdar '940, Matsue '193 and Carter '918 are used to account for the deficiencies of the primary

reference of Muraoka '142. However, Applicant respectfully submits that these cited references have been improperly combined.

One of ordinary skill in the art would not be motivated or reasonably expect to be successful in combining Muraoka '142 with any one of the other cited references since Muraoka '142 fails to disclose any use of 1,3-bis(citraconimidomethyl) benzene, or using 0.2-0.5 parts by weight of 1, 3-bis (citraconimidomethyl) benzene. While a reference need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combining references "must be clear and particular". See *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). There is no guidance in the primary reference of Muraoka '142 to achieve the formulations as presently claimed. Thus, this rejection is overcome.

Although the USPTO asserts that the motivation lies in Majumdar '940, Applicant respectfully traverses this conclusion.

First, using the USPTO's reasoning with regard to Majumdar '940 equals an invitation to experiment until the present invention is finally achieved, which is improper for an analysis of patentability under § 103(a). See *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (CAFC 1988) (In *In re Fine*, the CAFC reversed the BPAI by stating: "The Board reiterated the Examiner's bald assertion that "substitution of one type of detector for another in the system of Eads would have

been within the skill of the art," but neither of them offered any support for or explanation of this conclusion.") (emphasis added); see also *In re Deuel*, 34 USPQ2d 1210, 1216 (CAFC 1995) (where the court states: "Obvious to try" has long been held not to constitute obviousness. A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out") (citing *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-1681 (CAFC 1988)). Applicant respectfully submits that using the USPTO's conclusions for combining the cited references are improper since Majumdar '940 could be combined with any number of references of any type. A huge number of combinations of references are possible based on the rationale stated in the Office Action. This is nothing more than an invitation to experiment or an "obvious to try" rationale until the present invention can be obtained. Also, Applicant respectfully maintains the position that one of ordinary skill in the art would not refer to Muraoka '142, upon a reading of Majumdar '940, because there is no disclosure in Majumdar '940 of using the combination of components in Muraoka '142, and vice versa.

Second, there are too many inconsistencies between the cited references, and between the cited references and the present invention. For example, Majumdar '940 is directed to a cushion material for carcass and/or tread portion for retread tire (see Col. 1, line 23), whereas the chafer rubber composition of the present invention related to a chafing

material disposed in the tire bead portion to fit a tire rim. As another example of an inconsistency, nothing in Muraoka '142 suggests to one of ordinary skill in the art to use the cushioning material of Muraoka '940. Further, the Majumdar '940 reference discloses an elastomeric adhesive composition having a bis-imide compound, one or more elastomers, and a tackifier. Yet, Muraoka '142 uses no such materials in its rubber component. Thus, one of ordinary skill in the art would not refer to the cushion material of Majumdar '940, or the any of the other cited references, in order to achieve the present invention due to such inconsistencies.

Third, one of ordinary skill in this art would not refer to Majumdar '940, upon a reading of the primary reference, since the primary reference of Muraoka '142 already discloses sufficient or "high" hardness, durability and aging resistance (see Col. 1, lines 57-60; Col. 2, lines 5-11). Even the Examples in Muraoka '142 disclose achievements of "well-balanced" and "superior" properties (i.e., Col. 9, lines 1-5; Col. 11, lines 13-15). Thus, one of ordinary skill in the art would not be motivated to refer to another reference, such as Carter '918, when Muraoka '142 already teaches superior properties with its product.

Thus, Applicant respectfully submits that the present invention is patentably distinct from the cited combination of references, and that these references have been improperly combined.

Appl. No. 09/784,041

Art Unit 1733

Reply to Office Action of June 20, 2003

Conclusion

Based on the above remarks, Applicant respectfully submits that a *prima facie* case of obviousness has not been formed with respect to the asserted combination of Muraoka '142, Majumdar '940, Matsue '193 and Carter '918 because not all requirements for a *prima facie* case of obviousness have been satisfied. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

A full and complete response has been made to the Office Action. Applicant respectfully requests that a timely Notice of Allowance issue for this case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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